CLEMENT SETH ROBERTS (SBN 209203)
croberts@orrick.com
BAS DE BLANK (SBN 191487)
basdeblank@orrick.com
ALYSSA CARIDIS (SBN 260103)
acaridis@orrick.com
ORRICK, HERRINGTON & SUTCLIFFE LLP
The Orrick Building
405 Howard Street
San Francisco, CA 94105-2669
Telephone: +1 415 773 5700
Facsimile: +1 415 773 5759

SEAN M. SULLIVAN (*pro hac vice*)
sullivan@ls3ip.com
J. DAN SMITH (*pro hac vice*)
smith@ ls3ip.com
MICHAEL P. BOYEA (*pro hac vice*)
boyea@ ls3ip.com
COLE B. RICHTER (*pro hac vice*)
richter@ls3ip.com
LEE SULLIVAN SHEA & SMITH LLP
656 W Randolph St., Floor 5W
Chicago, IL 60661
Telephone: +1 312 754 0002
Facsimile: +1 312 754 0003

Attorneys for Sonos, Inc.

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA,

SAN FRANCISCO DIVISION

SONOS, INC.,	Case No. 3:20-cv-06754-WHA
Plaintiff and Counter-defendant,	Consolidated with Case No. 3:21-cv-07559-WHA
v.	**SONOS, INC.'S OPPOSITION TO GOOGLE'S MOTION FOR JUDGMENT AS A MATTER OF LAW RE VALIDITY**
GOOGLE LLC,	
Defendant and Counter-claimant.	Judge: Hon. William Alsup Courtroom: 12, 19th Floor Trial Date: May 8, 2023

1   I.   **INTRODUCTION**

2   Drawing all reasonable inferences in Sonos's favor, this Court should deny Google's

3   motion for judgment as a matter of law (JMOL) and allow the jury to decide whether the asserted

4   claims are invalid as obvious. In the alternative, the Court should grant Sonos's motion that

5   Google failed to meet its burden to show by clear and convincing evidence that the asserted

6   claims are invalid as obvious. Dkt. 754.

7   II.   **LEGAL STANDARD**

8   The Court must view the evidence in the light most favorable to the non-moving party,

9   *Reed v. Lieurance*, 863 F.3d 1196, 1204 (9th Cir. 2017), and must deny JMOL unless "no

10   reasonable juror could find in the non-moving party's favor." *Torres v. City of Los Angeles*,

11   548 F.3d 1197, 1205 (9th Cir. 2008).

12   III. **ARGUMENT**

13   Google had the burden to overcome the asserted patents' "presumption of validity" by

14   presenting "clear and convincing evidence" to the contrary. *SRAM Corp. v. AD-II Eng'g, Inc.*,

15   465 F.3d 1351, 1357 (Fed. Cir. 2006). A reasonable juror could find that Google failed to meet

16   that burden.

17   A.   **The Sonos 2005 System Does Not Teach Zone Scenes And Does Not Make The
                 Asserted Claims Obvious.**
18

19   Google's obviousness challenge relied heavily on the Sonos 2005 System. Google

20   contended that the Sonos 2005 System taught one "zone scene"—party mode—plus the ability to

21   create dynamic (i.e. single-use) speaker groups. So according to Google, the only change needed

22   to the Sonos 2005 System was the ability to save one additional speaker group.

23   Sonos showed that both of Google's premises were wrong. The Sonos 2005 System did

24   not have any zone scenes, including party mode. So simply saving another "zone scene" was not

25   the only change needed.

26   The Sonos 2005 System also lacked any ability to separately create and invoke zone

27   scenes. Dr. Schonfeld admitted "the actual Sonos prior art system didn't have the ability to save

28   regular zone scenes; correct? A. That's absolutely correct." 5/17/23 Tr. at 1477:2-5. Instead,

1   the Sonos 2005 System could create temporary, one-time use "zone groups." 5/18/23 Tr. at

2   1658:11-19. The zone group was "immediately launched into a group" and could not be

3   "previously saved." *Id.* As Mr. Millington explained, zone groups would not be saved "for

4   future use, no. All you can do is invoke it immediately. … [Y]ou can't come back the next day

5   and reapply that group." 5/8/23 Tr. at 328:11-20. In fact, as soon as any speaker is added or

6   removed from a group, the prior group "is gone." *Id*. at 328:21-329:7. *See also* 5/9/23 Tr. at

7   423:10-425:10. As Google itself acknowledges, users suggested changing "the way the Sonos

8   2005 System permitted users to create groups—by linking and unlinking speakers in real time"

9   because it was "cumbersome." Mot. at 8 (citing TX2424 at 1); *see also* Dkt. 566 at 24-25 (noting

10 the parties "generally agree on how [Sonos's 2005 System] grouping worked," including that

11 "they generally agree that this system did not allow for speaker groups that could be named,

12 saved, and later activated on-demand."). Because the "zone groups" were immediately invoked

13 and were not saved, they did not teach the set-up and invocation functionality in the asserted

14 claims.

15   Party Mode was also not a zone scene and does not meet all of the claim limitations

16 related to setting up, saving, and invoking speaker groups. 5/18/23 Tr. at 1659:21-1664:13. First,

17 Party Mode has no saved group membership—the Party Mode function would simply serially link

18 every speaker on the network to play together. 5/8/23 Tr. at 342:3-10, Tr. 343:5-19. Put

19 differently, Party Mode stores a rule for forming a group, it does not store the group itself. This is

20 like the "reply all" function in an email program. That function is (like party mode) "hard coded"

21 into the software, and – when invoked – will gather information to create a group of recipients for

22 an email message. But "reply all" itself is not a group but a rule. Thus, Party Mode is not a

23 "previously saved grouping according to a common theme," as required for a zone scene.

24   Second, in the 2005 system, Party Mode did not use the process followed by the claim.

25 As Dr. Schonfeld admitted, Party Mode was both created and invoked at one time. 5/17/23 Tr. at

26 1476:14-22; *see also* 5/11/23 Tr. at 904:16-24 (Almeroth: "I think one example was Party Mode

27 in the 2005 system. You're not keeping track of all the players in the system. You press the

28 button. It creates and invokes at the same time."). Indeed, Dr. Almeroth explained that

1   "instances where the creation and the invocation is what's called atomic," such that there would

2   be no "time or delay between when you create something and you invoke that same thing." *Id*. at

3   904:16-20. Third, as soon as the user left Party Mode, the group membership would disappear

4   until it was reconstituted the next time the user invoked Party Mode. 5/9/23 Tr. at 459:8-13 ("So

5   Party Mode wasn't saved in the -- the players that would play in Party Mode wasn't saved in the

6   system in the original design."); *see also id.* at Tr. 464:1-465:21.

7   Thus, even if Party Mode could be considered a "zone scene" under the Court's

8   construction, the way it was implemented did not satisfy the process set forth in the claim. For

9   this reason, it simply is not true that adding a second party mode (e.g. a winter party mode) or

10   some other "second zone scene" would bring the Sonos 2005 system within the scope of the

11   claims. Put differently, Google's argument about Party Mode fails both because it wasn't a zone

12   scene, and because (even if it was) the way it was implemented didn't satisfy the claim

13   limitations.

14   Although Google insists that Mr. Lambourne "conclusively established that the party

15   mode in the Sonos 2005 System was a zone scene," Mot. at 4, Mr. Lambourne explained why that

16   is not true. Mr. Lambourne's "Alarm Clock" specification included the statement that party mode

17   is an example of a zone scene. TX6544 at 27; 5/9/23 Tr. at 462:16-463:17. Mr. Lambourne

18   corrected that statement in the 2005/2006 timeframe. His "Zone Scenes" specification—the

19   "more accurate description of his zone scene technology" (*id.*, 461:19-3)—explained that zone

20   scenes were more flexible and powerful than Party Mode. TX6545; 5/9/23 Tr. at 457:9-21, Tr.

21   463:21-465:22; 5/10/23 Tr. at 610:9-611:8.[1] At best for Google, this is a dispute of fact going to

22   the "scope and content of the prior art" and the "differences between the prior art and the claims

23   at issue," which are issues for the jury to resolve. *Graham v. John Deere Co. of Kansas City*, 383

24   U.S. 1, 17 (1966).

25   As demonstrated above, the Sonos 2005 System relied on fundamentally different

26   architecture for linking speakers together. Instead of saved groups, the system allowed only ad

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[1] Besides, when Mr. Lambourne explained his invention to the Patent Office in his provisional application, he corrected the Alarm Clock specification by removing that mistaken sentence. *See* 5/19/23 Tr. at 1814:13-1815:5.

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hoc grouping that immediately invoked the speaker group. The Sonos 2005 System therefore

lacked several limitations of the asserted claims, including receipt of a "request to invoke" a zone

scene, sending requests to add a single zone player to multiple zone scenes, and saving a zone

scene. 5/18/23 Tr. at 1664:20-1666:22; Ex. 1 (Almeroth Invalidity Demonstratives) at PDX8.106

– PDX8.109.

Nothing in the prior art references (the knowledge of a POSITA, the Sonos Forums, the

Squeezebox system, and the Nourse patent) overcomes those deficiencies—and Dr. Schonfeld did

not even opine that it did. Instead, he relied on the secondary references to simply show *saving* a

group or the creation of *overlapping* groups. He did not opine that the secondary references

taught, for example, the basic architectural differences between ad hoc grouping and static

grouping requirements, like saving and invoking zone scenes. And he similarly failed to address

why a person of ordinary skill in the art would have been motivated to rework the Sonos 2005

System to add static speaker groups.

Knowledge of a person of ordinary skill: Dr. Schonfeld opined that a person of

ordinary skill could have added more zone scenes to a system. E.g., Dkt. 757 at 5. But he did not

opine that a person of ordinary skill would have found it obvious to separately create, save, and

later invoke multiple zone scenes. Dr. Schonfeld presented no opinion that making those changes

would have been obvious.

Sonos Forums: The Sonos Forums do not disclose how to save and later invoke saved

groups. The Forums do not say or suggest a way of implementing overlapping groups, much less

the process set forth in the asserted claims. The Forums introduced into evidence are simply a

discussion of features that users would like to see. And while they suggest using "macros" to

implement overlapping groups, that is like telling someone to use paper and pencil to make a

picture. Macros are simply "a series of instructions that a computer or technology or, in our case,

a player would sort of -- would sort of automatically go through." 5/9/23 Tr. at 434:5-9; Tr.

528:11-22 (a macro is "a sequence of instructions that happen in an automated way, like step one,

1   step two, step three.").[2] Thus macros are a *tool* that might allow you to create programming, but

2   the disclosure of macros does not teach or suggest the specific *solution* recited in the patent

3   claims. For this reason, Dr. Schonfeld did not opine that the Sonos Forums taught the claim

4   limitations directed to (for example) separately defining and saving the groups.

5   **Squeezebox:**   Dr. Schonfeld relied on the Squeezebox system to show overlapping

6   groups. But he admitted that he did not "add a single Squeezebox player to two different sync

7   groups that existed at the same time" on a single server and "no physical devices were in two

8   overlapping zones in [his] testing." 5/17/23 Tr. at 1482:22-1483:1, Tr. 1483:23-25. The jury is

9   free to disregard his testimony on the capability of the Squeezebox system for that reason alone.

10   Furthermore, Dr. Schonfeld did not show that the Squeezebox system made up for the limitations

11   missing from the Sonos 2005 system. For example, he admitted that the individual zone players

12   within the Squeezebox system do not communicate with each other in order to achieve

13   synchronization (in the Squeezebox system, synchronization is instead handled by a central

14   server), a significant difference between the claims and the Squeezebox system. *Id*. at 1484:9-20.

15   **Nourse:** Dr. Schonfeld relied on Nourse for limitations 1.7 and 1.8—creating a second

16   group of zone players—of the '885 patent. 5/17/23 Tr. at 1438:18-22. But Dr. Schonfeld

17   acknowledged that Nourse did not teach separately saving and invoking speaker groups—instead

18   the system would have to be modified to store group information. *Id.* at 1440:6-11. He did not

19   address how the system would have to be modified to later invoke groups. *Id.*

20   Moreover, other than the Forums posts, the Patent Office had extensive information about

21   all of the systems Schonfeld considered, plus the Nourse patent, and all that material was

22   considered by the Examiner during prosecution. 5/17/23 Tr. at 1488:1-1490:5. That leaves

23   Google with "a particularly heavy burden in establishing invalidity." *Impax Lab'ys, Inc. v.*

24   *Aventis Pharms. Inc.*, 468 F.3d 1366, 1378 (Fed. Cir. 2006).

25

26   _____

27   [2] Google's repeated suggestion that Mr. Lambourne obtained the idea of overlapping groups from
     the Forums posts is completely unsupported. E.g., Mot. at 9. Mr. Lambourne developed the idea
     for zone scenes separately from the Forum posts, as evidenced by his notebooks. 5/10/23 Tr. at
28   613:16-617:11; TX6539, TX8236.

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1   Finally, as to dependent claim 6, the combination of Party Mode and another group could

2   not invalidate that claim. Claim 6 requires "the first predefined grouping of zone players does not

3   include the third zone player, and wherein the second predefined grouping of zone players does

4   not include the second zone player." Because party mode includes *every* zone player in the

5   system, an additional zone scene with one fewer player does not meet claim 6. 5/18/23 Tr. at

6   1668:1-11.

7   **B.**   **Google Presented Insufficient Evidence On The "Display" Limitations In The**
         '966 Patent.
8

9   Apart from the failure to identify zone scenes in the prior art, Dr. Schonfeld presented no

10   analysis on how the prior art demonstrates Limitations 1.9 and 1.10 of claim 1 of the '966 patent.

11   These limitations require display of both zone scenes at the same time. Google offered no fact or

12   expert testimony establishing that any prior art reference teaches this limitation, nor that any

13   combination of the prior art would make it obvious.

14   Dr. Schonfeld testified that Sonos's 2005 prior art system satisfied limitations 1.9 and

15   1.10 of the '966 patent based on his analysis of Limitations 1.6 and 1.7 of the '885 patent.

16   5/17/23 Tr. at 1477:25-1478:11. But as Dr. Schonfeld acknowledged, the limitations of the '966

17   patent call for displaying a representation of the first zone scene and displaying a representation

18   of the second zone scene, while Limitations 1.6 and 1.7 of the '885 patent do not. *Id*. at 1478:7-

19   1479:7.[3]   And Dr. Schonfeld admitted "the display part is not there in the claim language" of

20   limitations 1.6 and 1.7 of the '885 patent. *Id*. at 1479:17-24. So Dr. Schonfeld's only "analysis"

21   of limitation 1.9 is to cross-reference his analysis of limitations 1.6 and 1.7 of the '885 patent. *Id.*

22   at 1480:16-24; *see also* 5/16/23 Tr. at 1390:12-17 ("Q. Looking at claim 1 of the '966 patent for

23   limitations from 1.0 to 1.6 and 1.9, what is your opinion on whether those limitations are

24   disclosed in the Sonos 2005 prior art system? A. Yeah. As I mentioned, those are all satisfied by

25   Sonos 2005 based on the same evidence and analysis I just presented for claim limitation 1.6 of

26   the '885 patent.").

27

28   ---
[3] Google's unsupported cross-referencing between the '885 and '966 patents was the subject of
Sonos's Motion in Limine No. 2.   Dkt. 594.

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Dr. Schonfeld's "analysis" of why Sonos's 2005 prior art system satisfied limitation 1.10

suffers the same fatal flaw—the only support he identifies for the proposition that limitation 1.10

was met came in this statement: "So based on the same evidence and analysis I just performed for

claim limitations 1.9 and 1.10 of the '885 patent, claim limitations 1.10 and 1.11 of the '966

patent are satisfied respectively." 5/17/23 Tr. at 1422:6-14. And while limitation 1.10 of the

'966 patent requires displaying a representation of the first zone scene and displaying a

representation of the second zone scene, limitations 1.9 and 1.10 of the '885 patent contain no

such requirement. In other words, Dr. Schonfeld's only "analysis" of why Sonos's 2005 prior art

system satisfied limitations 1.9 and 1.10 is an unexplained cross-reference to limitations of the

'885 patent that he admits do not contain analogous language at all. This fails as a matter of law.

C.   **Google Did Not Establish A Motivation To Combine Or Reasonable**
           Expectation Of Success.

Google did not show a motivation to combine or reasonable expectation of success. The

Federal Circuit has made clear that motivation to combine cannot be established by conclusory

expert testimony, particularly expert testimony that "primarily consisted of conclusory references

to [the expert's] belief that one of ordinary skill in the art *could* combine these references, not that

they *would* have been motivated to do so." *TQ Delta, LLC v. CISCO Sys., Inc.*, 942 F.3d 1352,

1359–60 (Fed. Cir. 2019) (emphasis in original). Similarly, the expert cannot simply "rel[y] on

the [challenged] patent itself as her roadmap for putting what she referred to as pieces of a 'jig-

saw puzzle' together." *Id.* at 1360. Expert testimony must not just explain *why* a person of

ordinary skill in the art would have combined elements, but why they would have done so "*in the*

way the claimed invention does." *Id.* (emphasis in original).

Google offers no motivation to combine evidence outside of Dr. Schonfeld's testimony,

and Dr. Schonfeld's testimony features each of these legal flaws. At a minimum, a reasonable

jury could find that a person of ordinary skill in 2005 would not have been motivated to combine

the references or would not have had a reasonable expectation of success in doing so.

For example, Dr. Schonfeld was asked why it would have been obvious to those skilled in

the art back in 2005 to combine Nourse with the Sonos 2005 prior art system. In response, Dr.

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1   Schonfeld testified that "[i]t's addressing management of speaker systems. They're both

2   addressed to the same type of topic. They are solving very similar problems of managing saving

3   zone groups and making them available and flexible to play individually or play later." 5/17/23

4   Tr. at 1441:4-10. That explanation merely states that combination was possible not, that a person

5   of ordinary skill in 2005 would have had reason to do so, much less a reason to do so in the way

6   the claimed invention does.

7   Similarly, Dr. Schonfeld was asked "would it have been obvious to those skilled in the art

8   back in 2005 when they looked at the Sonos 2005 system and also looked at the forum postings

9   about that system to make a combination in their mind?" 5/17/23 Tr. at 1431:22-25. In response,

10 he testified "Yeah, absolutely. The Sonos forum was posting of people who were interested --

11 users, dealers who were interested in the Sonos 2005 system, and they were making suggestions

12 of how to modify the Sonos 2005 system to improve it." *Id*. at 1432:1-4. Dr. Schonfeld offers no

13 explanation as to why a POSITA in 2005 would have been motivated to make "a combination" in

14 the way the claimed invention does.

15   As one more example, Dr. Schonfeld testified that a POSITA in 2005 would have

16 combined what was known in the Squeezebox system with the Sonos 2005 prior art system

17 because "they were competitors back then. They were trying to do the same type of system.

18 They would have looked into each other's system and tried to see what the competitor is doing

19 and they did." 5/17/23 Tr. at 1443:1-8. Once again, that conclusory opinion offers no

20 explanation whatsoever as to why a POSITA in 2005 would have been motivated to make this

21 combination in the way the claimed invention does.

22   Google also presented no evidence that there was a reasonable expectation of success in

23 arriving at the claimed invention. There is a "clear distinction in our case law between a patent

24 challenger's burden to prove that a skilled artisan would have been motivated to combine prior art

25 references and the additional requirement that the patent challenger also prove that the skilled

26 artisan would have had a reasonable expectation of successfully achieving the claimed invention

27 from the combination." *Eli Lilly & Co. v. Teva Pharms. Int'l GmbH*, 8 F.4th 1331, 1344 (Fed.

28 Cir. 2021). Dr. Schonfeld's testimony offers no analysis beyond conclusory statements that the

1   combination would have been "trivial" or "simple." *See, e.g.*, 5/17/23 Tr. at 1440:8-19, 1424:1,

2   18. For example, asked how difficult it would have been to store group identifiers, Dr. Schonfeld

3   responded that it would be a "trivial operation" and "a trivial thing to do" and "a trivial change"

4   because computing devices have sufficient memory to store group identifiers. *Id.* at 1440:8-19.

5   But that is like saying that it would be trivial to build a library inside of a basketball stadium

6   because there's plenty of room. Memory capacity is one requirement for storage, but it is hardly

7   the only problem to solve.

8   And in another case, Dr. Schonfeld's "trivial" conclusion is buttressed only with a

9   conclusion that the claims involve nothing more than "keep instead of discarding" a group. In Dr.

10 Schonfeld's words:

11   Q. How difficult would it have been back in 2005 timeframe to a person of
               ordinary skill in the art to make the modification of saving one of the extra
12   groups that was provided for in that system?

13
           A. It would be a trivial step in my view, and I can explain why.
14

15   Q. Can you please explain?

16   A. Sure. It's – we're talking about saving it for later and if you remember
               yesterday, I said you need two things: One is to continue to operate as you are
17   now until you need it later; and when you do need it later, you have to make
               sure it's available.
18
               So all you have to do is, if you remember yesterday, I said that there is a
19   channel that has to be shifted from the local playlist to the external playlist,
               you just move the same code in response to the play message instead of the set
20   AVTransport URI message; and then the same -- the same information that
               was saved already in persistent memory on the coordinator, the only
21   difference you just keep instead of discarding it when you no longer -- when
               you are done working with a particular zone group just like you would for the
22   Party Mode. So these are two very simple steps.
23

24   5/17/23 Tr. at 1423:22-1424:18. Dr. Schonfeld nakedly asserted that the process he

25 describes consists of "two very simple steps." But what did he actually testify to? He was asked

26 how hard it would be to make the modification of saving a group, and his answer was that it was

27 simple, because all you have to do is save it. That hardly addresses the fundamental problem with

28 his lack of explanation of how the prior art makes separately saving and invoking groups obvious.

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1   Meanwhile, Dr. Alermoth explained that the Sonos Forum posts evidence significant

2   "skepticism" such that "it is my opinion that a person of skill in the art would have been

3   dissuaded from modifying the Sonos 2005 system in view of the identified user posts from the

4   Sonos forum." 5/18/23 Tr. at 1675:9-12; *see also id*. 1676:3-25. At minimum, this is a dispute of

5   fact for the jury to resolve.

6   **D.   Google Did Not Address Objective Indicia Of Nonobviousness.**

7   Google's obviousness case fails to address the substantial evidence of objective indicia of

8   non-obviousness. "[E]vidence of secondary considerations may often be the most probative and

9   cogent evidence in the record." *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1332

10   (Fed. Cir. 2019) (quoting *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538 (Fed. Cir.

11   1983)). A fact-finder "must *always* consider any objective evidence of nonobviousness presented

12   in a case." *Transocean Offshore Deepwater Drilling, Inc. v. Maersk Contractors USA, Inc.*, 617

13   F.3d 1296, 1305 (Fed. Cir. 2010) (emphasis in original); *see also Ruiz v. A.B. Chance Co*., 234

14   F.3d 654, 667 (Fed. Cir. 2000) (holding that the district court erred by failing to consider

15   secondary considerations and observing that "[Federal Circuit] precedents clearly hold that

16   secondary considerations, when present, must be considered in determining obviousness.").

17   Dr. Schonfeld improperly ignored or discounted the evidence of secondary considerations.

18   For example, Google advanced testimony from Dr. Schonfeld that a 2020 article from CNN does

19   not give any praise to the specific claims in this case. 5/17/23 Tr. at 1455:13-1456:5. Dr.

20   Schonfeld similarly testified that the article fails to say anything about overlapping group scenes

21   specifically. *Id.* But "there is a presumption of nexus for objective considerations when the

22   patentee shows that the asserted objective evidence is tied to a specific product and that product

23   'is the invention disclosed and claimed in the patent.'" *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317,

24   1329 (Fed. Cir. 2016). Here it is undisputed that Sonos's 2020 system practices the claimed

25   invention, and Google did not even attempt to rebut the presumption of nexus. And the jury also

26   saw an article from Tech Hive describing multiple groups including upstairs, downstairs, back of

27   house and front of house. Dr. Almeroth explained that this demonstrated praise for overlapping

28

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1   groups specifically. 5/18/23 Tr. at 1679:11-1680:3, Tr. 1703:3-15. Dr. Schonfeld offered no

2   basis to disregard the evidence of industry praise.

3   Dr. Almeroth also testified about longstanding skepticism that overlapping zone scenes

4   were possible. 5/18/23 Tr. at 1674:16-1676:25; TX6958. And the jury heard ample evidence

5   about Sonos's commercial success, as well as Google's commercial success with its products that

6   embody the claims (and its refusal to disable speaker grouping functionality). Dr. Schonfeld's

7   failure to account for that evidence in his own obviousness analysis is a sufficient basis for the

8   jury to find that Google failed to carry its burden of proof.

9   **E.   Google's Obviousness Case Relies On Hindsight.**

10   Dr. Schonfeld committed the cardinal sin of obviousness analysis—analysis based on

11   hindsight. As the Supreme Court has held, "[a] factfinder should be aware, of course, of the

12   distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post*

13   reasoning." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 421(2007). *See also Graham*, 383 U.S.

14   at 36 (warning against a "temptation to read into the prior art the teachings of the invention in

15   issue" and instructing courts to "guard against slipping into use of hindsight").

16   Dr. Schonfeld engaged in hindsight-based analysis. Although he testified that he was

17   considering obviousness at the time of the invention, he never acknowledged what a person of

18   skill in the art would have known at the time of the invention. For example, Dr. Schonfeld's

19   references to what a POSITA would have known at the time comes in the form of conclusory

20   statements that certain modifications would be "trivial" or obvious to that person without any

21   explanation of why or how it would have been trivial to a POSITA in 2005. *See, e.g.*, 5/17/23 Tr.

22   at 1424:19-1425:2 (Q: "[H]ow difficult would it be for that person -- would it have been for that

23   person back in 2005 to make the simple modifications that you were just describing?" A: "In my

24   opinion, it would have been a trivial exercise to do. You are just shifting one code and not

25   discarding the identifiers. That's a very simple operation to do in the code."); *id.* at 1425:5-12

26   (Q: "[A] person of ordinary skill in the art back in 2005 could make the modification -- would it

27   have been obvious to make the modification that you talked about to save the first zone group

28   here for later? Is that your testimony?" A: "It is my testimony. The moment you just decide that

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1   that's what you want to do, you can do it immediately."). Dr. Schonfeld did not provide

2   sufficient explanation on how or why a person of ordinary skill would "shift[] one code" to arrive

3   at the claimed invention, absent using Sonos's specifications as a roadmap to arrive at the claims.

4   In contrast, Dr. Alermoth was careful to look at the obviousness question from the

5   perspective of "a person of ordinary skill in the art but, more importantly, it has to be done from

6   the time period in December 2005. You can't consider it from the perspective of today. It has to

7   be from 2005." 5/18/23 Tr. at 1669:11-16; *see also id*. at 1650:16-1651:2. He explained that

8   there was no reason to alter the Sonos 2005 System to add zone scenes; instead, that analysis

9   "shows hindsight bias." *Id*. at 1681:6-12. Based on this dispute between the experts, a

10 reasonable jury could find that Dr. Schonfeld did not show, by clear and convincing evidence,

11 that the asserted claims would have been obvious to a person of ordinary skill in the art at the

12 time of the invention.

13   **F.   The Prior Art As A Whole Does Not Enable The Claims.**

14   To invalidate a claim as obvious, "the prior art, taken as a whole, must enable a skilled

15 artisan to make and use the claimed invention." *Raytheon Tech. Corp. v. Gen. Elec. Co.*, 993

16 F.3d 1374, 1380 (Fed. Cir. 2021). Although Google argues that the prior art need not enable the

17 claims (Mot. at 7), the Federal Circuit is clear that "that if an obviousness case is based on a non-

18 self-enabled reference, and no other prior art reference or evidence would have enabled a skilled

19 artisan to make the claimed invention, then the invention cannot be said to have been obvious."

20 *Id.* at 1377.

21   None of Google's cited cases excuse that requirement. Mot. at 7-8. Google first cites *In*

22 *re Epstein,* where there was no dispute that the prior art *actually disclosed* the claimed features

23 and the applicant merely disputed whether "one skilled in the art would have known how to

24 implement the features of the references." *In re Epstein*, 32 F.3d 1559, 1568 (Fed. Cir. 1994).

25 Here, however, Sonos disputes whether any of the prior art references disclose static groups at all,

26 let alone how a system that only allows for dynamic groups would be altered to allow for static

27 groups. Google's other two cases are about simple substitution where the purportedly missing

28 feature of the prior art was not a key feature of the claims. For example, in *Uber* the claims

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1   required "server-side" location plotting instead of "terminal-side." *Uber Techs., Inc. v. X One,*

2   *Inc.*, 957 F.3d 1334, 1339 (Fed. Cir. 2020). But "the alleged novelty of the '593 patent is not

3   related to the differences between server-side or terminal-side plotting," and the specification

4   admitted that both techniques already existed, so it was obvious to substitute one for another. *Id.*

5   at 1339-40. And in *Publicover*, 813 F. App'x 527, 532 (2020), the Federal Circuit found that

6   claims to a virtual reality headset that tracked a known type of eye movement was obvious. The

7   prior art disclosed headsets that tracked eye movement, and disclosed tracking the known

8   "vestibulo-ocular movement." *Id.* at 531. As an additional basis for upholding the PTO's

9   invalidity finding, the Court "note[d]" the PTO's finding the specification briefly described this

10   eye movement by "provid[ing] the 'well-known' definition of vestibulo-ocular movement." *Id.*

11   Given the well-known description, there was no need for the prior art to contain detailed

12   descriptions of "how to modify [the prior art] system to identify vestibulo-ocular movement." *Id.*

13   So here again, the prior art was simply used to add well-known features to the primary reference,

14   not to modify the primary reference to include entirely new features (e.g., multiple saved,

15   overlapping groups) with no details on how to implement that change.

16   Here, Google did not introduce sufficient evidence for any reasonable juror to conclude

17   that its alleged prior art enabled a person of ordinary skill in the art to make and use the claimed

18   invention of either asserted patent. Google relies on the general knowledge of person of ordinary

19   skill to (1) come up with a new design for saving and invoking groups or (2) the Sonos Forums as

20   a way to restructure the Sonos 2005 System to allow for saved, overlapping groups. There is no

21   dispute that the Sonos Forums do not contain implementation details on how create, save, and

22   invoke overlapping groups. Instead, once again, Dr. Schonfeld provided conclusory testimony

23   boiling down to naked assertions that it would have been obvious how to make and use the

24   claimed invention. *See, e.g.*, 5/17/23 Tr. at 1425:5-12 (Q: "[A] person of ordinary skill in the art

25   back in 2005 could make the modification -- would it have been obvious to make the

26   modification that you talked about to save the first zone group here for later? Is that your

27   testimony?" A: "It is my testimony. The moment you just decide that that's what you want to do,

28   you can do it immediately.").

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Thus, the Court should reject Google's obviousness claims as a matter of law, or at a minimum allow the jury to decide.

IV.   CONCLUSION

Sonos respectfully requests that the Court deny Google's motion for judgment as a matter of law.

Dated: May 22, 2023

ORRICK HERRINGTON & SUTCLIFFE LLP
and
LEE SULLIVAN SHEA & SMITH LLP

By: */s/ Clement Seth Roberts*
     Clement Seth Roberts

Attorneys for Sonos, Inc.

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